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PATENT
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:)
ALAIN BETHUNE et al.) Group Art Unit: 1734
Application No. 09/506,795) Examiner: G. Koch, III
Filed: February 18, 2000)
For: MATERIAL SUPPLY STRIP,)
SYSTEM, AND METHOD OF)
APPLYING PIECES OF)
MATERIAL TO OBJECTS)

Mail Stop Appeal Brief—Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

REPLY BRIEF UNDER 37 C.F.R. § 41.41

Pursuant to 37 C.F.R. § 41.41, Appellants present this Reply Brief in response to the Examiner's Answer dated January 17, 2006. Appellants also have filed a Request for Oral Hearing concurrently herewith.

If there are any fees due in connection with the filing of this Reply Brief that are not enclosed herewith, please charge such fees to our Deposit Account No. 06-0916.

I. INTRODUCTION

Appellants submit this Reply Brief to address several erroneous assertions set forth in the Examiner's Answer.¹ First, the Examiner has misinterpreted the disclosure of this application in an apparent attempt to maintain his improper rejection of claims 1-26, 28-35, 73, and 76 under 35 U.S.C. §112, ¶1. Contrary to the Examiner's allegations, this application expressly discloses that pieces of material on opposing sides of the supply strip could be of different sizes. Accordingly, the Examiner's §112 rejection should be reversed.

Second, the Examiner has failed to establish a proper rejection of claims 1-5, 8-10, 12, 14, 21, 28, 73, and 76 based on 35 U.S.C. §103(a). The combination of the references cited by the Examiner fails to teach or suggest multiple features recited in these claims. Moreover, the Examiner also has failed to establish any teaching or suggestion to combine these references in the manner asserted in his rejection. Accordingly, the Examiner's §103 rejection also should be reversed.

II. ARGUMENT IN REPLY

A. The Examiner's Rejection of Claims 1-26, 28-35, 73, and 76 Based on Alleged Noncompliance With the Written Description Requirement Relies Upon a Mischaracterization of the Disclosure of the Application

Each of claims 1-26, 28-35, 73, and 76 recites a method of applying pieces of material to objects comprising, *inter alia*, "providing a material supply strip" that includes "a backing" having "pieces of material removably arranged on" first and second opposing surfaces of the supply strip, wherein "the pieces of material on the first

¹ Appellants have endeavored to address assertions in the Examiner's Answer without unduly repeating the same arguments in Appellants' opening brief. Appellants' Reply to the Examiner's Answer dated January 17, 2006, however, is similar to Appellants' Reply to the Examiner's Answer dated May 17, 2005.

surface have a different size than the pieces of material on the second surface.”²

(See claims 1 and 76 (emphasis added).) In his Answer, the Examiner apparently attempts to defend his claim rejection based on 35 U.S.C. §112, ¶1, asserting:

Neither the specification as originally filed, [n]or the French document incorporated by reference discloses that the pieces of material on the first surface of the supply strip backing have a different size than the pieces of material on the second surface.

(Ex. Ans. at 3.)^{3,4}

Contrary to the Examiner’s assertion, however, the original specification **expressly** discloses that the pieces of material on the first surface of the supply strip could have a different size than the pieces of material on the second surface of the supply strip. Specifically, when describing possible configurations of labels 7 on the first surface of the supply strip and labels 6 on the second surface of the supply strip, the specification states:

The labels 7, 6 are shown as being uniformly spaced along the backing 5 and being substantially uniform in shape and size. One of ordinary skill in the art would recognize, however, that the invention could be practiced with labels having many different configurations (e.g., different size, different shape, different labeling information).

² In his answer, the Examiner rejected claim 72 under 35 U.S.C § 112, ¶ 1, notwithstanding that this claim was previously withdrawn as directed to a non-elected claim group and/or species. See, e.g., Office Action dated January 2, 2002. To the extent the examiner intended to include claim 72 in his rejection under § 112, ¶ 1, Appellants submit that this rejection of claim 72 should be reversed for the same reasons as the corresponding rejection of claims 1-26, 28-35, 73, and 76.

³ Citations to “Ex. Ans. at ___” refer to the Examiner’s Answer dated January 17, 2006.

⁴ In his Answer, the Examiner appears to have modified his new-matter rejection to withdraw his erroneous allegation that the original application “provides no support for centering the pieces of material on the first and second surface of the supply strip.” (See Office Action dated September 22, 2004, at 3.) As explained in Appellants’ opening brief, this claimed feature was expressly disclosed in the original application. (See Appeal Brief at 13.)

(Application at 14:7-11 (emphasis added).) The originally-filed specification thus expressly explains that the labels 7 on the first surface of the supply strip could have a “different size” than the labels 6 on the second surface of the supply strip.

Despite this express disclosure, the Examiner inexplicably alleges that the application does not “explicitly” disclose labels of different sizes on opposite surfaces of the supply strip:

The specification does not explicitly state that the labels on one backing material has labels on a first surface of the backing material of one size, and labels on the second surface of the backing material of another size.

(Ex. Ans. at 11.) According to the Examiner, “one of ordinary skill in the art … would interpret the statement [cited above] to indicate that from processing run to processing run … the labels are the same size.” (*Id.*)

The Examiner’s strained interpretation of this disclosure, however, simply is not reasonable. Although an embodiment illustrated in the drawings shows that labels 7 and 6 could be identical to one another (see, e.g., Fig. 3), Appellants’ application expressly states that a person of ordinary skill in the art would recognize that labels 7 and 6 alternatively could be of different sizes (Application at 14:7-11). Thus, this application supports claims that recite a supply strip having differently sized pieces of material on opposing surfaces of the strip.

Although the above-mentioned disclosure provides sufficient support for the claims, the application contains additional support. For example, the application also states that the labels on the first and second surfaces of the support strip could be positioned substantially opposite to one another (e.g., centered) when they are of a different “format” to lessen weakening from the cutting tool during production:

In an embodiment, the backing includes labels on the first surface positioned substantially opposite to corresponding labels on the second surface. **This configuration is preferable when labels of different format are provided on the first and second surfaces of the backing, because the backing experiences less weakening from the cutting tool during production.**

(Application at 11:2-6 (emphasis added).) Based on this disclosure, a person of skill in the art would understand that different “format” means different size and/or shape since centering labels of different size and/or shape would decrease the locations at which the cutting tool would be applying pressure to both sides of the backing.

The Examiner has completely misinterpreted this disclosure. Summarily alleging that different “format” means different “labeling information” (Ex. Ans. at 11), the Examiner ignores the teaching that the “format” of the labels has an impact on the weakening of the backing from the cutting tool (Application at 11:2-6). Since the cutting tool has no role in stamping “labeling information” onto the labels, the use of different “labeling information” would have absolutely no effect on whether the cutting tool weakens the backing. The Examiner’s interpretation thus is erroneous. A person of ordinary skill in the art would plainly understand that the specification discloses that the size and/or shape of the labels could differ on opposing surfaces of the supply strip.

Accordingly, the Examiner’s rejection of claims 1-26, 28-35, 73, and 76 based on 35 U.S.C. §112, ¶1, should be reversed.

B. The Examiner Has Failed to Establish a *Prima Facie* Case of Obviousness for Claims 1-5, 8-10, 12, 14, 21, 28, 73, and 76

1. The Cited References Fail to Teach or Suggest Centering Opposing Pieces of Material of Different Sizes

The Examiner has rejected claims 1-5, 8-10, 12, 14, 21, 28, 73, and 76 based on 35 U.S.C. §103(a) in view of DE 2212995 of Schafer, U.S. Patent No. 6,306,475B1 to

Stoq et al., and JP 05-294054 of Iwao. Each of these claims recites a method of applying pieces of material to objects comprising, *inter alia*, "providing a material supply strip" that includes the following two features:

1. the pieces of material on the first surface have a different size than the pieces of material on the second surface; and
2. the pieces of material on the first surface are centered with respect to corresponding pieces of material on the second surface.

(See independent claims 1 and 76.)

Appellants discovered that these features of the claimed invention provide a supply strip that has significant advantages over the prior art. In order to appreciate these advantages, however, a brief review of the manufacturing process for supply strips is appropriate. To make a double-sided supply strip, the following steps are performed: (1) strips of material are glued to opposite surfaces of a backing strip by an adhesive layer; (2) a cutting tool cuts the material into pieces (e.g., labels); and (3) the supply strip is wound into a roll.

If the pieces of material on each surface were the same size and were lined up with respect to corresponding pieces on the opposing surface, the cutting tool may spread excess adhesive from the edges of the pieces onto the outer surface of the supply strip. Since supply strips are typically wound into a roll immediately after cutting the pieces of material, however, the excess adhesive may glue the supply strip to itself as it is wound into a roll. When applying pieces of material with an applicator device, such a roll would not dispense pieces of material properly and could jam the applicator device. Appellants have found that this adhesive-spreading problem can be minimized

if the pieces of material on each surface of the supply strip are of a different size and are centered with respect to one another.

Turning now to the obviousness rejection, the Examiner primarily relies upon Schafer, alleging that this reference discloses a method that includes a supply strip having “labels of different shape . . .” (Ex. Ans. at 3-4.) While acknowledging that Schafer contains no disclosure of centering corresponding labels on opposing surfaces of the supply strip, as recited in the rejected claims, the Examiner alleges that it would have been obvious to modify Schafer to have this feature. Despite this assertion, however, the Examiner fails to explain why a person skilled in the art would have been motivated to make this hypothetical modification since Schafer, in fact, teaches away from centering corresponding labels on opposing surfaces of the supply strip.

As explained in Appellants’ opening brief, Schafer discloses a label strip having labels on opposing sides staggered with respect to one another and a feed device specifically designed to dispense labels having this staggered configuration. (Appeal Brief at 15; Schafer translation at 11; Figs. 1-4.) In view of this teaching away, a person of ordinary skill in the art would not have been motivated to use a supply strip with corresponding labels centered with respect to one another. See MPEP §2141.02 (“A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.”).

Additionally, the Examiner has failed to cite any reference that teaches or suggests modifying Schafer to have corresponding labels of different sizes on opposing surfaces centered with respect to one another. Although the Examiner relies upon Iwao for alleged disclosure of this feature (Ex. Ans. at 12), this reference teaches lining up

the edges of labels of exactly the **same** size and shape, not centering labels of **different** sizes (see Figs. 1, 3, and 4). Moreover, Iwao's disclosure of lining up the edges of labels does not broadly disclose the concept of centering opposing labels of any size, as suggested by the Examiner. (Ex. Ans. at 12.) Iwao fails to disclose any reasons why pieces of material on opposing sides of a supply strip should be lined up or centered. Since Iwao contains no disclosure of centering labels of different sizes on opposing surfaces of a supply strip, the Examiner's reliance upon it for that feature is misplaced.

Accordingly, the Examiner has failed to establish a *prima facie* case of obviousness of claims 1-5, 8-10, 12, 14, 21, 28, 73, and 76.

2. The Cited References Fail to Make Obvious a Supply Strip Having the Backing and Pieces of Material Formed of Substantially the Same Material

Claims 1-5, 8-10, 12, 14, 21, 28, and 73 recite, "the backing and the pieces of material being formed of substantially the same material." While the Examiner relies solely upon Stocq et al. for alleged disclosure of this feature, this reference does not provide any teaching or suggestion to modify the supply strip of Schafer to have the backing and labels made from substantially the same material.

Stocq et al. generally discloses that a backing sheet could be made of any number of materials:

Backing sheet 9 can be selected from clear polymeric films, such as those used for the face sheet, glassine paper or any other suitable, preferably UV-transmissive material. More preferably it consists of clear BOPP, polypropylene, or clear polyethylene.

(Stocq et al., col. 3:52-56.) This disclosure, however, does not teach that a backing sheet should be made of substantially the same material as the pieces of material (e.g., labels). Rather, Stocq et al. merely discloses a “laundry list” of possible materials that could be used for the backing sheet. Although some of the possible materials for the backing sheet overlap with the possible materials for a “face” sheet, Stocq et al. does not teach that the backing and face sheets necessarily should be made of the same material. Certainly, Stocq et al. provides no suggestion or motivation for modifying the label strip of Schafer to have the backing and labels made of substantially the same material.

Nevertheless, relying upon this disclosure, the Examiner asserts that “Stocq disclos[es] that label and liners **can be of** the same material.” (Ex. Ans. at 12 (emphasis added).) In other words, the Examiner alleges that it would have been *obvious to try* using the same material for the backing and the pieces of material based on Stocq et al. But “obvious to try” is not the standard for assessing patentability under 35 U.S.C. §103. *In re Roemer*, 258 F.3d 1303, 1310 (Fed. Cir. 2001). Rather, the Examiner must show a teaching or suggestion to make the backing and the pieces of material from substantially the same material. See MPEP §2143. Since the Examiner has failed to do so, for this additional reason, the Examiner has failed to establish a *prima facie* case of obviousness for claims 1-5, 8-10, 12, 14, 21, 28, and 73.

C. The Examiner’s Obviousness Rejections of Dependent Claims 6, 16, 20, 22-26, and 29-35 Are Improper

Claims 6, 16, 20, 22-26, and 29-35 depend from claim 1 and, therefore, should be allowed for at least the same reasons as claim 1.

Claims 16 and 20 additionally recite that piece(s) of material on the first surface of the supply strip are different from piece(s) of material on the second surface of the strip. The Examiner rejected these claims as obvious based on the combination of Schafer, Stocq et al., Iwao, and U.S. Patent No. 3,861,986 to Wochner. While the Examiner relies upon Wochner for alleged disclosure of different labels on different sides of a double-sided label strip (Ex. Ans. at 14), Wochner teaches a single-sided label strip. (Wochner, col. 2:13-21). As such, the Examiner's reliance upon Wochner for this feature is misplaced. For this additional reason, the Examiner's rejection of claims 16 and 20 is improper.

III. Conclusion

For the reasons set forth above and in Appellants' opening brief, the Examiner's claim rejections under 35 U.S.C. §§103 and 112 are improper and should be reversed.

Respectfully submitted,

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Dated: March 10, 2006

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